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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/836,144	04/17/2001	Hiroko Iwasaki	2271/50717-AY	7345
<div>7590 01/29/2007 RICHARD F. JAWORSKI Cooper &amp; Dunham LLP 1185 Avenue of the Americas New York, NY 10036</div>			<div>EXAMINER MCPHERSON, JOHN A</div>	
			<div>ART UNIT 1756</div>	<div>PAPER NUMBER</div>
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		01/29/2007	PAPER	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

## Office Action Summary

Application No.

09/836,144

Applicant(s)

IWASAKI, HIROKO

Examiner

John A. McPherson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 16 November 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 12 and 16-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 12 and 16-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |                                                                                                            |                                                                                         |
|------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                           | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____                                                |

## **DETAILED ACTION**

### ***Response to Amendment***

1. This Office Action is responsive to the Amendment filed 11/16/06.
2. The Amendment filed 11/16/06 successfully overcomes the rejection set forth in paragraph 3 of the Office Action mailed 6/15/06, accordingly this rejection is withdrawn.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 12 and 16-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 4,902,584 to Uchiyama et al. (Uchiyama) in view of US 1,156,693 to Ide et al. (Ide) for the reasons of record as set forth in paragraph 4 of the Office Action mailed 6/15/06, and as further discussed below.

4. Claims 12, 16 and 18-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 1,156,693 to Ide et al. (Ide) in view of 4,920,007 to Sawamura et al. (Sawamura) for the reasons of record as set forth in paragraph 5 of the Office Action mailed 6/15/06, and as further discussed below.

***Response to Arguments***

5. Applicant's arguments filed 11/16/06 have been fully considered but they are not persuasive.

With respect to the rejection over Uchiyama in view of Ide, Applicant argues that Uchiyama proposes a magneto-optical recording medium which operates by a different physical principal than an optical information recording medium, and therefore there is no motivation for modifying the magneto-optical recording medium proposed by Uchiyama by applying the teachings of Ide which are directed to an optical information recording medium. However, Uchiyama is directed to an optical recording medium comprising a recording layer on a substrate and a protective layer formed adjacent to the upper or lower surfaces of the recording layer (see the abstract), wherein the recording layer is either a magneto-optical recording layer or a phase conversion type recording layer. See column 6, line 62-column 7, line 17 and column 25, lines 3-4 for specific disclosure of phase conversion type recording layers. Therefore, Uchiyama and Ide are both directed to the same type of optical recording media, specifically optical recording media comprising phase conversion recording layers.

With respect to the rejection over Ide in view of Sawamura, Applicant argues that Sawamura proposes a magneto-optical recording medium comprising a magnetic recording layer and a protective layer, which is not relevant to the presently claimed subject matter. However, it is the position of the Examiner that the disclosure of an improved protective layer for an optical recording medium including an opto-magnetic recording layer, such as taught by Sawamura, is relevant to an optical recording

medium comprising a phase change recording layer, because the prior art recognizes utilizing the same protective layers in both types of optical recording media. For example, Uchiyama teaches a protective layer useful with either a magneto-optical recording layer or a phase conversion type recording layer (see above). Similarly, US 4,847,132 to Takao et al. (cited by the Examiner in the Office Action mailed 9/16/03), which is an English-language member in the same patent family as JP 63-259855 (cited in background section of the present specification), discloses a protective layer for optical recording media, wherein the recording layer is exemplified by either a phase change type material (e.g. see Example 1) or a magneto-optical material (e.g. see Example 8).

### ***Conclusion***

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John A. McPherson whose telephone number is (571) 272-1386. The examiner can normally be reached on Monday through Friday, 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Huff can be reached on (571) 272-1385. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
John A. McPherson  
Primary Examiner  
Art Unit 1756

JAM  
1/24/07